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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,087	02/01/2000	SHUNPEI YAMAZAKI	0756-2203	1193

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EXAMINER

JACKSON JR, JEROME

ART UNIT PAPER NUMBER

2815

DATE MAILED: 08/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/583,087

Applicant(s)

YAMAZAKI, SHUNPEI

Examiner

Jerome Jackson Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-41 and 43-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-41 and 43-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17,21.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/30/02 has been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 21-41, 43-90 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-46 of U.S. Patent No. 6,023,075 in view of Sumiyoshi '075, Akiyama, and Misawa. From Sumiyoshi it would have been obvious to have practiced a pixel electrode above the leveling film, and Akiyama and Misawa suggest simultaneous processing for pixel and peripheral transistors.

Claims 21-41, 43-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang with Misawa, Yamazaki, Baldi, Sumiyoshi, and Akiyama.

The previous rejection still applies. The new limitations regarding a pixel electrode over the leveling film are not patentable because Sumiyoshi shows the advantages of such structure. See figure 1 of Sumiyoshi where electrode 111 overlies leveling film 110. Additional new limitations regarding the same process for peripheral and pixel transistors are also not patentable because the final product is obvious

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regardless of the process. Both Akiyama and Misawa teach similar transistors formed in the same process for both peripheral and pixel areas.

Patentability of a product by process claim is determined by the final product, regardless of how actually made, In re Hirao 190 USPQ 15 at 17 (footnote 3). See also In re Brown 173 USPQ 685; In re Luck 177 USPQ 523; In re Fessman 180 USPQ 324; In re Avery 186 USPQ 161; In re Wertheim 191 USPQ 90; and In re Morosi 218 USPQ 289, all of which make it clear that it is patentability of the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that applicant has the burden of proof in such cases, as the above caselaw makes clear.

New claims reciting spectroscopy properties, product by process language, mobilities, or other functional language are rejected as above. The prior art likewise functions in the same manner and has the same properties. Note again that Misawa teaches the same mobilities for peripheral and pixel transistors.

Applicant's arguments filed 7/30/02 have been fully considered but they are not persuasive. Arguments regarding leveling film for peripheral and pixel transistors in Misawa and Akiyama are unconvincing of patentability because they do not address the suggestions of Sumiyoshi. Arguments regarding Sumiyoshi likewise are unconvincing of patentability because they are directed against Sumiyoshi alone. Note that Sumiyoshi clearly teaches a pixel electrode over the leveling film and Misawa and Akiyama teach peripheral and pixel transistors of high mobility and similar structure. Together the references suggest applicant's claimed invention.



JEROME JACKSON
PRIMARY EXAMINER